



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/763,607	04/19/2001	Cord F. Stahler	100564-00049	3440

6449 7590 08/26/2003

ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
1425 K STREET, N.W.  
SUITE 800  
WASHINGTON, DC 20005

EXAMINER

BAKER, MAURIE GARCIA

ART UNIT	PAPER NUMBER
----------	--------------

1639

DATE MAILED: 08/26/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Pat nt and Trademark Office**  
**COMMISSIONER OF PATENTS AND TRADEMARKS**  
Washington, D.C. 20231

DEA/FCE-1994

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/763,607	04/19/2001	STAHLER	100564-00049

EXAMINER	
Maurie Garcia Baker, Ph.D.	
ART UNIT	PAPER NUMBER
1639	9

DATE MAILED:

**Please find below a communication from the EXAMINER in charge of this application**

Commissioner of Patents

Please see attached Notice of Non-Responsive Amendment.

**DETAILED ACTION*****Notice of Non-Responsive Amendment***

1. The Response filed June 2, 2003 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

The Restriction Requirement mailed March 5, 2003 required election of a single invention from Groups I or II and a further election of species depending on the Group elected. Applicant elected Group I for examination with traverse. Although applicant denotes an election of species in the Response, this election is unclear and does not fulfill the requirements set forth in the Restriction Requirement. Importantly, applicant has not identified the claims readable on the elected species, which was also required (paragraph 12 of the previous action). Thus the Response filed June 2, 2003 is not fully responsive for these reasons.

Specifically with respect to the unclear election, if Group I was elected, then applicant was required to elect from two patentably distinct species. The requirement is reiterated below:

**1: Species of biologically or chemically functional materials**

Applicant is required to elect, for purposes of search, a single, specific type of biologically or chemically functional material from those set forth in the claims (e.g. claim 14). Note that applicant should denote whether a library of such materials is elected or not (i.e. claim 16). If a library is elected, the library should be fully defined as much as possible so that the *core structure that is present in all library members is specifically delineated*. Also note that the synthesis methodology should also be elected (e.g. claims 15 or 17 or 22/23, etc.)

**2: Species of illumination matrix arrangement**

- |                      |          |
|----------------------|----------|
| A. Transmitted light | claim 19 |
| B. Reflected light   | claim 20 |

Applicant's election with respect to Species 1 above is unclear. Although applicant does clearly elect nucleic acids as the biologically or chemically functional material, it is unclear whether a library of such materials is further elected or not. Thus, it is unclear from this election whether claim 16 would read on the elected species. Also, the examiner required that the synthesis methodology be elected. Applicant states that the materials are "synthesized on the carrier in two or more stages from monomeric or/and oligomeric building blocks". It is unclear from this election whether claims 17 and/or 22/23 would also read on the elected species or not. As noted above, a listing of claims readable on the elected species was not provided. For these reasons, the examiner cannot determine what claims should be under examination and also where to begin the search in the instant case.

Note that the traversal will be fully addressed when the case is examined on the merits.

2. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

4. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306- 3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
August 25, 2003

A handwritten signature in black ink, consisting of stylized initials 'MB' followed by a long horizontal line.

MAURIE GARCIA BAKER PH.D  
PRIMARY EXAMINER